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Paper No. 15
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Direct Checks Unlimited, Inc. by change of name from
Current, Inc.

Serial No. 75/446,294

Anna W. Manville of Merchant & Gould P.C. for Direct Checks
Unlimited, Inc.

John C. Tingley, Trademark Examining Attorney, Law Office 106
(Mary Sparrow, Managing Attorney).

Before Seeherman, Hairston and Holtzman, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Direct Checks Unlimited,
Inc. to register INSIGNIA as a mark for the following goods and
services:¹

Bank checks, checkbook covers, address labels, accounting
journals, bookkeeping journals, and other check-related
parts thereof. Class 16

¹ Serial No. 75/446,294; filed March 6, 1998 on the Principal Register
alleging a bona fide intention to use the mark in commerce.

Mail order services featuring bank checks, checkbook covers, address labels, accounting journals, and bookkeeping journals. Class 35

Printing services; namely printing of personalized bank checks and address labels. Class 42

Registration has been finally refused under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of applicant's goods and services.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

The Trademark Examining Attorney contends that the word INSIGNIA, when considered in relation to the identified goods, describes a "feature" of applicant's goods and services in that it refers to the emblem that is placed on applicant's printed goods, such as bank checks, and describes applicant's mail order and printing of such goods with the "insignias" placed thereon. In support of his position, the Examining Attorney has relied on a dictionary definition of "insignia" as meaning "badges, emblems, or other distinguishing marks, as of rank, membership, etc." The Examining Attorney has also submitted excerpts of articles from the NEXIS database showing that banks place their

insignias on checks. For example, an article appearing in the *Richmond News-Leader* states that (emphasis added):²

Most changes will be phased in gradually. For example, as customers of any of the predecessor banks run out of checks and reorder them, the new checks will come with the NationsBank **insignia**. (January 1, 1992).

Applicant, on the other hand, argues that INSIGNIA is suggestive in that it requires multi-stage reasoning to determine the "nature" of the goods and services and "does not immediately tell consumers that the Applicant offers printing services, mail order services, checks, and other printed items." Applicant contends that the dictionary definition cited by the Examining Attorney does not support the position that the mark is descriptive because "applicant's goods do not consist of badges or emblems" and its printing and mail order services "do not necessarily involve the application of an emblem or badge." Similarly, applicant argues that the NEXIS references only

² This evidence was attached to the Examining Attorney's response to applicant's request for reconsideration. A number of other NEXIS articles accompanied the Examining Attorney's final refusal. However, it is clear from applicant's request for reconsideration that applicant received a copy of only one of those articles and we note that the Examining Attorney, in his response to the request for reconsideration, did not acknowledge the missing attachments. Under the circumstances, none of the evidence attached to the final action has been considered. Even if we were to consider this evidence, it would be of little persuasive value since, for the most part, the articles were obtained from wire services or foreign sources (including the one excerpt applicant did receive), or showed use of the term as a business name or trade name, or in several instances consisted of duplicate or even multiple copies of the same stories.

support a conclusion that "insignia" describes emblems or symbols such as those that might be used by a bank or a federal agency but that the articles do not show that the term "is used to identify" applicant's goods and services. Applicant has relied on a list of eight third-party registrations purporting to show that INSIGINA has been registered for a variety of goods such as directory boards, pencils, carpeting, fruits and decorative faucets.³ Applicant reasons that although the goods identified by the marks in those registrations may, just as applicant's goods, have an emblem or distinguishing mark place on them, the term INSIGNIA was not found to be descriptive of those goods.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The question of whether a particular term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought. See In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986).

³ Listing third-party registrations, unsupported by copies of the registrations, is not sufficient to make the registrations of record. However, since the Examining Attorney has treated these registrations as being properly of record, we will consider this evidence for whatever probative value it may have.

With these principles in mind, we find that the word INSIGNIA is merely descriptive of a significant feature of applicant's goods and services. In relation to those goods and services, the term immediately, and without the exercise of any imagination, tells purchasers that applicant's bank checks are imprinted with insignias, that applicant will print insignias on bank checks for customers, and that customers can mail order bank checks imprinted with insignias. There is no question as to the meaning of the word "insignia." The dictionary definition submitted by the Examining Attorney shows that an insignia is any distinguishing mark or emblem of an organization, and applicant acknowledges that "insignia" describes emblems or symbols such as those that might be used by a bank. Moreover, the NEXIS evidence is sufficient to show that banks put insignias on checks.

Applicant admits that INSIGNIA "would likely be perceived by consumers to mean a symbol or emblem" but contends that a "consumer" might think that "the services might involve monogramming or some similar service...." First, it is not necessary for prospective purchasers to be able to correctly guess any particular aspect of the goods and services based only upon consideration of the mark. As indicated previously, descriptiveness is not determined in a vacuum or on the basis of speculation but rather in relation to the particular goods or services. Moreover, descriptiveness is determined from the

viewpoint of the relevant purchasers for the goods or services. In re Abcor Development Corp., 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978). Among the primary customers for applicant's printed bank checks are banks. These purchasers would immediately understand the meaning of INSIGNIA in relation to applicant's checks and its check ordering and printing services, and would naturally assume that the checks are, or can be, imprinted with the purchasing bank's logo or insignia.

We also note that while applicant admits that "a bank insignia might appear on a check printed by the Applicant," applicant maintains that a bank insignia "would not necessarily [appear] on checkbook covers, address labels and the other [printed items]." However, it is well settled that registration is properly refused if the mark is merely descriptive of any of the items of goods in the application. See In re Canron, Inc., 219 USPQ 820 (TTAB 1983). The term INSIGNIA is descriptive of at least one of the items produced and/or imprinted with an insignia.

Nor are we persuaded by the third-party registrations. Those marks are registered for goods which are entirely different from the goods and services herein, and therefore offer little help in making a determination of the merits of this case. As often noted by the Board, each case must be determined on its own set of facts and must be determined on the basis of the

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identified goods and services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); and *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977). Thus, the mere existence of these registrations does not justify the registration of INSIGNIA in this case.

Accordingly, we find that the mark INSIGNIA is merely descriptive of applicant's goods and services.

Decision: The refusal to register is affirmed.